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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,796	09/19/2001	Eric DeFranco	110024	1327

25944 7590 07/15/2003

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EXAMINER
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LEWIS, PATRICK T

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 07/15/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/869,796

Applicant(s)

DEFRANCO ET AL.

Examiner

Patrick T. Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14. 6) ☐ Other:

## DETAILED ACTION

### *Priority*

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. PCT/FR00/00011, filed on January 5, 2000.

### *Claim Objections*

2. Claim 23 is objected to because of the following informalities: claim does not end with a period. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims reading upon a compound of general formula (I), (I'), or (II) are indefinite. The attachment of the linker **L** to the nucleotide **W** has not been properly defined. In the absence of a recitation of the specific atoms participating in the chemical bond between **L** and **W**, all claims reading upon said formulae are indefinite as one of ordinary skill in the art at the time of the invention would not be apprised of the metes and bounds of the instant invention.

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The term "nucleotide analog" renders all claims reading upon said term indefinite. In the absence of distinct modifications to the chemical core claimed or distinct language to describe the structural modifications or the chemical names of modified compounds of this invention, the identity of said analogs would be difficult to describe and the metes and bounds of said analogs applicant regards as the invention cannot be sufficiently determined because they have not been particularly pointed out or distinctly articulated in the claims.

The term **L** has not been sufficiently defined. **L** is described as "comprising at least four atom". No atoms are identified. Furthermore, the language is open-ended meaning any combination of atoms, arranged in any manner, reads upon **L**. The specific atoms applicant intends to read upon **L** along with their arrangement/connectivity is required to apprise one of ordinary skill in the art of the metes and bounds of the instant invention.

The variable **B** has not been defined.

6. Claims 7 and 19 recites the limitation "the nitrogen containing base " in line 2. There is insufficient antecedent basis for this limitation in the claim.

7. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). Claims 9 and 21 depend ultimately from independent claims 1 and 13,

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respectively. Claims 1 and 13 read upon a nucleotide and polynucleotide, respectively. The compounds of claims 9 and 21 do not read upon either. A nucleotide must have a phosphate attached at the 2', 3', or 5' position.

8. In claim 13, the phrase "compound having interacted with a labeling reagent" is indefinite in all occurrences. The "interaction" has not been set forth. In the absence of the nature of the interaction, one of ordinary skill in the art would not be apprised of the metes and bounds of the instant invention.

### ***Conclusion***

9. Claims 1-27 are pending. Claims 1-27 are rejected. No claims are allowed. Klevan et al. U.S. Patent 4,828,979 teaches nucleotide analogs for nucleic acid labeling and detection wherein the a "linker" is attached to the nucleotide via a nitrogen-base is cited to show the state of the art

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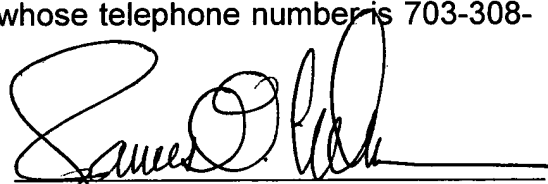
**Contacts**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick T. Lewis whose telephone number is 703-305-4043. The examiner can normally be reached on M-F 10:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 703-308-4624. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Patrick T. Lewis, PhD  
Examiner  
Art Unit 1623

  
James O. Wilson  
Supervisory Patent Examiner  
Technology Center 1600

ptl  
July 11, 2003